

## REMARKS

Applicants respectfully request reconsideration of the above-identified application. Claim 25 has been canceled, and Claims 1, 10, 12, 14, 22, 26, 28, and 35 have been amended. Thus, Claims 1-24, 26, and 28-36 remain pending in the present application. Applicants acknowledge with appreciation that Claims 30-34 and 36 have been allowed.

Claims 1-11 were rejected in the September 13, 2002, Office Action (hereinafter "Office Action") under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,328,328, to Finiel (hereinafter "Finiel"). Claims 12-26, 28, 29, and 35 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,367,793, to Deacon et al. (hereinafter "Deacon et al."). Applicants respectfully submit the claims of the present application are in condition for allowance. The reasons why applicants believe the claims of the present application are in condition for allowance are discussed in detail below.

### Rejections Under 35 U.S.C. § 102

Claims 1-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Finiel. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co., California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). For the following reasons, applicants respectfully assert that Finiel fails to teach or suggest each and every element of these claims.

### Independent Claim 1

As amended, Claim 1 recites an outsole of an athletic boot comprising a frame member secured to the outsole, and at least one adjustment member adjustably mounted on the frame member, a portion of which is adapted for engagement with a binding. The adjustment member is extendable in a selected amount away from the frame member. As will be discussed in more

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detail below, Finiel fails to teach or suggest an outsole of an athletic boot comprising a frame member secured to the outsole.

In contrast with the present invention, Finiel purportedly discloses a support wedge 4 journaled on the sides of a snowboard binding base 1. The thick portion 5 of the support wedge 4 is fixed to the binding base 1 by a screw 8 engaged with a nut 10 arranged on the binding base 1. Column 2, lines 9-20. The inclination angle of the support wedge 4 is adjustable by screwing or unscrewing the screw, as shown best in Figure 3B. However, applicants respectfully assert that Finiel fails to teach or suggest an outsole of an athletic boot having a frame member secured thereto and at least one adjustment member adjustably mounted on the frame member. Therefore, for at least this reason, Finiel fails to teach or suggest each and every element of amended Claim 1. Thus, applicants respectfully request the withdrawal of the pending rejection under § 102(e) with regard to Claim 1. Accordingly, applicants respectfully request that the Examiner also withdraw the pending rejections to Claims 2-9, which depend from allowable Claim 1.

#### Dependent Claim 9

Claim 9 adds to the novel aspects of applicants invention by including fore and aft cleats removably coupled to the frame member. Applicants respectfully assert there is no teaching in Finiel of fore and aft cleats removably coupled to either the binding base or the support wedge. Accordingly, applicants assert that Finiel fails to teach or suggest the additional element recited in Claim 9. Thus, for at least this additional reason, applicants respectfully request the withdrawal of the pending rejection under § 102(e) with regard to Claim 9.

#### Independent Claim 10

As amended, Claim 10 recites an outsole of an athletic boot comprising a frame member disposed within the outsole and having first and second ends, at least one base member coupled

to either of the first and second ends of the frame member, at least one spacer having a binding contact surface adapted to contact the binding, and at least one binding attachment member coupled to the outsole. The spacer of the outsole is adjustably mounted to the base member for selective orthogonal adjustment relative to the frame member. As will be discussed in more detail below, Finiel fails to teach or suggest an outsole of an athletic boot comprising a frame member disposed within the outsole, and at least one binding attachment member coupled to the outsole.

For the same reason as discussed above with regard to Claim 1, Finiel fails to teach or suggest a frame member disposed within the outsole of an athletic boot. Further, Finial fails to teach or suggest at least one binding attachment member coupled to the outsole of an athletic boot. Therefore, for at least these reasons, Finiel fails to teach or suggest each of the elements of amended Claim 10. Thus, applicants respectfully request withdrawal of the pending rejection under § 102(e) with regard to Claim 10. Accordingly, applicants respectfully request that the Examiner also withdraw the pending rejection to Claim 11, which depends from allowable Claim 10.

#### Claim Rejections Under 35 U.S.C. § 103

Claims 12-26, 28, 29, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deacon et al. Applicants respectfully traverse the rejections of these claims. For the reasons discussed below, applicants respectfully assert that these claims are in condition for allowance.

#### Independent Claim 12

As amended, Claim 12 recites a snowboard boot selectively mountable to a binding. The snowboard boot includes an upper attached to an outsole, a base member embedded within the outsole, and an adjustment member having an engagement portion and a threaded portion, and at

least one binding attachment number coupled to said outsole. The adjustment member is threadably adjustable relative to the base member so that the engagement portion of said adjustment member projects a selective amount away from the base member. As will be discussed in more detail below, Deacon et al. fails to teach or suggest a snowboard boot that includes at least one binding attachment member coupled to the outsole.

The Office Action states that Deacon et al. discloses a boot 1 comprising an upper 1, an outsole 2 with frame embedded with a plurality of threaded portions 3 for receiving a plurality of adjustment members, each comprising a threaded portion 13 and an engagement portion 11. However, the Office Action states that Deacon et al. does not disclose the boot for use with a binding. Accordingly, the Office Action takes official notice that the boot of Deacon et al. could easily be used with a snowboard soft shoe binding and the cleats would inherently act as spacers between the boot and the binding. Therefore, the Office Action states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the shoe of Deacon et al. with a binding generally known in the art.

Applicants agree with the Office Action that Deacon et al. does not disclose the boot for use with a binding. However, applicants respectfully assert that Deacon et al. fails to teach each and every limitation of amended Claim 12, including at least one binding attachment member coupled to the outsole. Moreover, applicants respectfully submit there is no suggestion or motivation to include a binding attachment member with the golf shoe of Deacon et al.

In contrast with the present invention, Deacon et al. purportedly discloses in the background of the invention a metal spiked golf shoe 1 that includes a plurality of metal spikes 4 which are attached to the sole 2 of a golf shoe 1. Each metal spike 4 includes a molded unitary body 5 having a disc shaped flange 7 and a threaded stud 9 formed on the upper surface of the flange. A pair of installation tool engagement holes 8 are provided at diametrically opposing

points in the bottom surface of the flange 7 to facilitate the threaded engagement of the threaded studs 9 in each threaded hole 3 within the sole 2 of the golf shoe 1. However, Deacon et al. fails to teach or suggest "at least one binding attachment member coupled to said outsole," as recited in amended Claim 12. Moreover, a suggested modification of the golf shoe of Deacon et al. to include a binding attachment member coupled to the outsole would destroy the intended purpose of Deacon et al., that is, to function as a golf shoe. Accordingly, Deacon et al. is not properly combinable with any reference teaching at least one binding attachment member coupled to the outsole of an athletic boot.

Under Section 103, a *prima facie* case of obviousness is established only if the cited references, alone or in combination, teach or suggest each of the limitations of a recited claim. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). As applied to Claim 12 of the present application, the cited reference, Deacon et al., fails to teach or suggest a snowboard boot having at least one binding attachment member coupled to its outsole. Furthermore, applicants respectfully assert that Deacon et al. cannot be properly combined to include a binding attachment member coupled to an outsole. For at least these reasons, applicants respectfully request the withdrawal of the § 103 rejection with regard to Claim 12. Accordingly, applicants further request the Examiner also withdraw the pending rejection to Claim 13, which depends from allowable Claim 12.

#### Independent Claim 14

As amended, Claim 14 recites an athletic boot selectively mountable to a binding. The athletic boot includes an upper fixedly secured to an outsole, an interface adjustment mechanism for adjusting the interface between the boot and the binding, and at least one binding attachment member coupled to the outsole. The interface adjustment mechanism is disposed within the outsole and has at least one adjustment member being extendable in a selective mount away from the outsole. As will be discussed in detail below, Deacon et al. fails to teach or suggest an

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athletic boot selectively mountable to a binding that includes at least one binding attachment member coupled to the outsole.

For the same reasons as discussed above with regard to Claim 12, Deacon et al. fails to teach or suggest at least one binding attachment member coupled to the outsole of the boot. Moreover, applicants respectfully assert that Deacon et al. cannot be properly combined to include a binding attachment member coupled to the outsole. Thus, for at least these reasons, applicants respectfully request the withdrawal of the § 103 rejection with regard to Claim 14. Accordingly, applicants respectfully request that the Examiner also withdraw the pending rejections to Claims 15-21, which depend from allowable Claim 14.

#### Independent Claim 22

As amended, Claim 22 recites a snowboard boot selectively mountable to a binding. The snowboard boot includes an outsole having a bottom surface, an elongated frame disposed within the outsole, at least one base member mounted to the frame, and at least one adjustment member adjustably mounted on the base member for selective substantially orthogonal adjustment relative to the outsole. The elongated frame extends between about the toe end of the snowboard boot to about the heel end of the snowboard boot. As will be discussed in more detail below, applicants respectfully assert that Deacon et al. fails to teach or suggest each of the elements of amended Claim 22, including a frame that extends between about the toe end of the snowboard boot to about the heel end of the snowboard boot.

As was described above, Deacon et al. purportedly discloses a metal spike golf shoe 1, includes a plurality of metal spikes 4 that are attached to the sole 2 for the golf shoe 1 through threaded holes 3. Conversely, the present invention, as defined by amended Claim 22, recites an elongated frame to which the adjustment member is adjustable mounted through a base member. The elongated frame is disposed within the outsole and extends between about the toe end and

about the heel end of the snowboard boot. Thus, applicants respectfully assert that Deacon et al. fails to teach or suggest an elongated frame disposed within the outsole that extends to between about the toe end and about the heel end of the snowboard boot. Therefore, for at least this reason, applicants respectfully request the withdrawal of the § 103 rejection with regard to Claim 22. Accordingly, applicants further request the Examiner also withdrawal the pending rejections to Claims 22-24, 26, and 28-29, which depend from allowable Claim 22.

#### Dependent Claim 28

Claim 28 adds to the novel aspects of applicants' invention by including fore and aft cleats removably coupled to the frame. For the same reasons as discussed above with regard to Claims 12 and 14, applicants respectfully asserts that Deacon et al. fails to teach or suggest fore and aft cleats removably coupled to the frame. Moreover, applicants respectfully assert that Deacon et al. cannot be properly combined to include fore and aft cleats removably coupled to the frame. Accordingly, applicants assert that Deacon et al. fails to teach or suggest the additional element recited in Claim 28. Therefore, applicants respectfully request the withdrawal of the § 103 rejection with regard to Claim 28.

#### Independent Claim 35

As amended, Claim 35 recites an athletic boot in combination with a binding to which the boot may be selectively coupled in a fixed disposition. The boot includes an outsole, at least one interface adjustment member selectively securable to said outsole, and at least one binding attachment member coupled to the outsole. As will be discussed in more detail below, applicants respectfully assert that Deacon et al. fails to teach or suggest each and every element of amended Claim 35, including at least one binding attachment member coupled to the outsole.

For the same reasons as discussed above with regard to Claims 12 and 14, Deacon et al. fails to teach or suggest at least one binding attachment member coupled to the outsole.

Moreover, applicants respectfully assert that Deacon et al. cannot be properly combined to include a binding attachment member coupled to the outsole. Thus, for at least these reasons, applicants respectfully request the withdrawal for the § 103 rejection with regard to Claim 35.

CONCLUSION

In light of the foregoing amendments and remarks, applicants submit that all of the claims of the present application are in condition for allowance. Applicants respectfully request entry of the amendments and the allowance of all pending claims. If any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

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In the Claims:

1. (Twice Amended) An outsole of an athletic boot [interface adjustment mechanism for adjusting the interface between a boot and a binding] comprising:

a frame member secured [securable] to said outsole [a boot]; and

at least one adjustment member adjustably mounted on said frame member, a portion of which is adapted for engagement with a [the] binding, said adjustment member being extendable in a selected amount away from said frame member.

10. (Twice Amended) An outsole of an athletic boot selectively mountable to a binding [interface adjustment mechanism for adjusting the interface between a boot and a binding] comprising:

a frame member disposed within said outsole and having first and second ends;

at least one base member coupled to either of said first and second ends of said frame member; [and]

at least one spacer having a binding contact surface adapted to contact the binding, said spacer adjustably mounted to said base member for selective orthogonal adjustment relative to said frame member; and

at least one binding attachment member coupled to said outsole.

12. (Amended) A snowboard boot selectively mountable to a binding comprising:

an upper attached to an outsole;

a base [frame] member embedded within said outsole and having a threaded portion opening out of said outsole; and

an adjustment member having an engagement portion and a threaded portion threadably engaged with said portion [threaded] surface of said base [frame] member, said adjustment member being threadably adjustable relative to said base [frame] member so that said engagement portion of said adjustment member projects a selective amount away from said base [frame] member.

14. (Amended) An athletic boot selectively mountable to a binding comprising:  
an upper fixedly secured to an outsole; [and]  
an interface adjustment mechanism for adjusting the interface between said boot and the binding, said interface adjustment mechanism disposed within said outsole and having at least one adjustment member, said adjustment member being extendable in a selected amount away from said outsole; and  
at least one binding attachment member coupled to said outsole.

22. (Twice Amended) A snowboard boot having toe and heel ends, said boot selectively mountable to a binding, comprising:  
an outsole having a bottom surface;  
an elongated frame disposed within said outsole, said frame extending between about said toe end and about said heel end at said boot;  
at least one base member [nonremovably] mounted to said frame [outsole]; and  
at least one adjustment member adjustably mounted on said base member for selective substantially orthogonal adjustment relative to said outsole.

26. (Twice Amended) The snowboard boot of Claim 22 [23], wherein said outsole defines at least one adjustment member mounting aperture opening to said bottom surface, said base member mounted within said adjustment member mounting aperture.

28. (Amended) The snowboard boot of Claim 22 [25], further comprising fore and aft cleats, said fore and aft cleats removably coupled to said frame [member].

35. (Amended) An athletic boot in combination with a binding to which the boot may be selectively coupled in a fixed disposition, comprising:

a binding having a boot interface surface and at least one boot attachment member;

a boot having an outsole;

at least one interface adjustment member selectively securable to said outsole of said boot and having a binding interface surface that contacts the boot interface surface of said binding when said boot is coupled to said binding, said interface adjustment member being extendable in a selected amount away from said outsole of said boot; and

at least one binding attachment, coupled to said outsole, said binding attachment member configured to cooperatively attach to said boot attachment member in a releasable manner.

Claim 25 has been canceled.